



Attention: EXAMINER RUDY ZERVIGON
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GROUP 1763 PERSONNEL: THE DOCUMENT TO FOLLOW IS A

RESPONSE AFTER FINAL

including:

- ☒ Response under 37 CFR §1.116
- ☐ Notice of Appeal
- ☐ Appeal Brief under 37 CFR §1.192 (filed in triplicate)
- ☐ Reply Brief under 37 CFR §1.193(b)(1) (filed in triplicate)
- ☐ Continued Prosecution Application (CPA) Request Transmittal
- ☐ Other: _____

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for filing in **U.S. Patent Application Serial No. 09/624,810**

SPECIAL STATUS

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Gary M. Hartman

Gary M. Hartman

January 10, 2003

Date



OFFICIAL

PATENT
Docket No. 13DV-13228

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Robert W. Bruce et al.

Examiner: Rudy Zervigon

Serial No.: 09/624,810

Art Unit: 1763

Filed: July 24, 2000

For: ELECTRON BEAM PHYSICAL VAPOR DEPOSITION APPARATUS

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SUPPLEMENTAL REPLY UNDER 37 CFR §1.116

Assistant Commissioner for Patents
Washington, D.C. 20231

Please charge fees incurred in the filing of this response to General Electric Company, Deposit Account No. 07-0865.

An Advisory Action dated November 29, 2002 (Paper No. 13), was unresponsive to Applicants' replies filed September 30, 2002, and November 8, 2002. Applicants respectfully request that the Examiner comply with MPEP 706.07 and 707.07(f).

Related to the on-sale/public use issue existing in the present application, Applicants' undersigned representative held Telephone Interviews of December 11 and 16, 2002, with Supervisory Patent Examiner Gregory L. Mills and SPRE Christine Tierney, the former of whom advised that an on-sale/public use rejection pertaining to the

very same EBPVD coater at issue in the present claims could be overcome in U.S. Patent Application Serial No. 09/624,808 if Applicants filed an affidavit/declaration that appropriately clarifies two issues: (1) when experimental use ended (concluding in an actual reduction to practice); and (2) supervision and control of the experimental use by the inventors. During the interview, Examiner Mills and Applicants' undersigned representative discussed rules found in the MPEP that pertain to on-sale/public use rejections under 35 USC §102. Examiner Mills concluded that the decision in *Field v. Knowles; Field and Stover v. Same*, 86 USPQ 373 (CCPA 1950), provided guidance to address the issue, the critical language being when the "practical utility of the invention for its intended purpose" was demonstrated "beyond probability of failure." Examiner Mills emphasized that the measure of "probability of failure" is not when the life of the coater or its components were shown to meet the life expectancy of previous designs. Instead, Examiner Mills directed Applicants to explain when sufficient testing had been completed to convince Applicants that the coater and its components performed well enough to demonstrate that failure was unlikely.

In response, Applicants have submitted a Declaration of Robert W. Bruce in U.S. Patent Application Serial No. 09/624,808, and now submit herewith a Declaration of Mr. Bruce, who is co-inventor of the claimed subject matter of the present application. Mr. Bruce's Declaration seeks to comply with Examiner Mill's instructions that Applicants should

clarify the nature and extent of testing, the nature and degree of control exercised by the inventor(s) over the testing, and any commercial exploitation (or lack thereof) of the parts produced by the device prior to the critical date.

Applicants believe that Mr. Bruce's Declaration complies with the Examiner's instructions by explaining in some depth:

(a) the nature and extent of the testing performed on the EBPVD coater recited in the claims, including discussion as to when and to what extent the coater was "tested under actual working conditions" and eventually "operated for a sufficient length of time to demonstrate continued and adequate production"¹ (Paragraph (5) of the Declaration);

(b) the nature and degree of control exercised by Mr. Bruce over the testing (see the second paragraph on page 2, the first full paragraph on page 5, and Paragraph (7) of the Declaration); and

(c) the limited commercial exploitation of the parts produced by the coater prior to the critical date of August 4, 1999, namely, about thirty-six parts were processed² and, following engineering scrutiny and discussion, received final authorization on September 9, 1998, and thereafter released to production (see the second paragraph on page 2, the first full paragraph on page 5, and Paragraph (7) of the Declaration).

¹*Field v. Knowles*, supra.


² About thirty-six parts were processed because it is the number of parts (blades) required to equip one gas turbine engine for which the parts were designed.

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Mr. Bruce also explains in his Declaration the engineering basis for deciding when the individual coater components/systems of particular significance to the claims were tested "beyond the probability of failure." (See Paragraph (6) of the Declaration).

In view of the above, Applicants respectfully request that their patent application be given favorable reconsideration. The Examiner is asked to call Applicants' undersigned representative if he/she has any questions with respect to the above, or any other matter now of record.

Respectfully submitted,

By 
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January 10, 2003
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Attachment: Declaration of Robert W. Bruce